TRADEMARK LAW OFFICE 101
Serial Number: 76/167351
Mark: NATURIS
Please Place on Upper Right Corner
**of Response to Office Action ONLY **

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of: **Lidl Stiftung & Co. KG**

Serial No.	**76/167351**	§	Trademark Attorney:
Filed:	**November 17, 2000**	§	Michael D. Tinyk
Mark:	**NATURIS**	§	Trademark Law Office 101

11-12-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #01

Commissioner of Trademarks
Box Responses – NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

REQUEST FOR RECONSIDERATION
RESPONSE TO FINAL OFFICE ACTION

Sir:

This is a response to an office action dated May 9, 2002 in this application. Applicant is simultaneously submitting a Notice of Appeal.

AMENDMENT

Identification of Goods

Please amend the specification of goods by deleting the identification as filed in its entirety and replacing it with the following:

WATER IN INTERNATIONAL CLASS 32.

REMARKS

The Application has been refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on Registration No. 1106249. Applicant amends its description of goods, by deleting every item except "water in International Class 32." In view of the amendment of goods and additional factors, including the different channels of trade and lack of market interface based on the nature of Applicant's intended use of the mark discussed below, there is no likelihood of confusion with the cited registration. Accordingly, Applicant respectfully requests the refusal be withdrawn.

No Likelihood of Confusion

The application for registration of NATURIS has been refused based on Registration No. 1106249, NATURAS for "fruit and vegetable juices" in International Class 32. Sharing a similar name alone is insufficient to establish likelihood of confusion. (See *Standard Brands, Inc. v. Eastern Shore Canning Co,* 81 USPQ 573 (1949) finding no likelihood of confusion between V-8 for vegetable juice and VA for tomato juice.) Additionally, the goods, as amended, are not related or not marketed in a way that would create the incorrect assumption they originated from the same source. While the issue of likelihood of confusion frequently revolves around the similarity or dissimilarities of marks and the relatedness of goods, other *du Pont* factors must also be considered. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 177 USPQ 563, 567 (C.C.P.A. 1973). When considering *all* the relevant factors, the purchasing public should not be confused or mistakenly assume that Applicant's goods or services originated with, are sponsored by, or are in some way associated with the goods sold under the cited registration. Other relevant factors include (1) the market interface between Applicant and Registrant, (2) the channels of trade, (3) the variety of goods on which a mark is or is not used, and (4) the extent to which Applicant has a right to

exclude others from use of its mark on its goods. No one factor is determinative. The ultimate inquiry is whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or confused, as to the source of the goods. *See McCarthy on Trademarks and Unfair Competition* § 23:2 (1996). In this case, after considering each factor in context with all of the other factors, the ultimate conclusion must be that there is no likelihood of confusion.

Confusion is not likely if the goods are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source. The market interface between the products is such that there is no danger that consumers will believe that the products have a common source because Applicant is a large discount retailer and Applicant's products will be sold only in Applicant's stores. Where the identification of goods in a registration is restricted to certain narrow channels of trade, there may be no likelihood of confusion for similar marks. *See In re Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988). The channels of distribution are different because Applicant's product will not be sold in the same stores as Registrant's products. Only if deemed necessary, Applicant will restrict its channel of trade for this application to include that Applicant's product will only be sold in its stores. Based on the total lack of physical proximity in the marketplace as a result of the isolation of Applicant's products in its stores, there should be no likelihood of confusion as to source of the goods.

Further, both Applicant's mark and Registrant's mark are or will be used as a "product mark", covering a specific product, rather than as a house mark or family mark, *e.g.* Applicant's NATURIS for water and Registrant's NATURAS for juices. Additionally, there is no evidence of any likelihood that the Registrant will bridge the gap into the area of business associated with the Applicant's goods. Therefore, Applicant's goods as amended and Registrant's goods are not to be

marketed in such a way that they would be encountered by the same persons in situations that would be likely to cause confusion.

The strength of the mark also affects the degree of protection it will be accorded. *See McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979. As the Examiner asserted in the final office action, "numerous English cognates use the same root ("Natur") for words dealing with nature or things that are natural." The cited mark is suggestive and entitled only to a narrow scope of protection because multiple registrations already coexist containing the Latin root "Natur". Numerous pre-existing registrations owned by various entities also is persuasive evidence of the lack of any potential confusion (See *Exhibit A.*) As a result of the numerous pre-existing registrations, consumers seeing both marks will not likely create an immediate association between the two products. The cited mark, therefore, should be afforded the appropriate level of protection because of the weakness of the root "Natur," which further assures lack of confusion between the products and parties.

The relative strength of the cited mark and the additional factors identified above, when considered together, outweigh any similarities of the marks or proximity of goods. Therefore, there is no likelihood of confusion, and Applicant respectfully requests the basis for the refusal be withdrawn.

Identification of Goods

The identification of goods Applicant has amended the identification of goods in accordance with 37 C.F.R. 2.71(a); TMEP 1402.06.

CONCLUDING REMARKS

Applicant believes that this paper is responsive to every point raised by the Examining Attorney in the Office Action dated May 9, 2002. No fee is believed to be required with this Response; however, please apply any charges not

covered, or any credits, to Deposit Account No. 50-0591 (Reference No. 07522.030001). No outstanding objections or refusals should remain. Accordingly, Applicant respectfully requests that the application pass to publication.

Respectfully submitted,

Date: Nov. 12, 2002

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I certify that this document is being deposited on Nov 12, 2002, with the U.S. Postal Service as first class mail under 37 C.F.R. § 1.8 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

Charlotte L. Cookingham

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Trademark Application of:	**Lidl Stiftung & Co. KG**		
Serial No.	**76/167351**	§	Trademark Attorney:
Filed:	**November 17, 2000**	§	**Michael D. Tinyk**
Mark:	**NATURIS**	§	**Law Office 101**

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U.S. Patent & TMOfc/TM Mail Rcpt Dt. #01

To The Trademark Trial And Appeal Board:

In accordance with 37 C.F.R. § 2.142, Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner. Application for registration of NATURIS, Serial Number 76/167351 in International Class 32, based on Section 44(e) of the Trademark Act, was refused under Trademark Act, Section 2(d), 15 U.S.C. § 1052(d) on the grounds of likelihood of confusion.

Applicant simultaneously is submitting a Request for Reconsideration of the final action dated May 9, 2002.

Enclosed is a check for $100.00 for the appeal fee for this one-class application.

Respectfully submitted,

Date: Nov. 12, 2002

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Charlotte L. Cookingham
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MP